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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/284,615 06/25/99 TERSKIKH

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001095
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HM22/0529

EXAMINER

UNGAR, S

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

05/29/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/284,615

Applicant(s)

Nair

Examiner

Ungar

Art Unit

1642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 28, 2001.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4, 5, and 8-33 is/are pending in the application.
- 4a) Of the above, claim(s) 8-10 and 13-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 11, 12, and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other: _____

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1. The Amendment filed March 28, 2001 (Paper No. 10) in response to the Office Action of September 29, 2000 (Paper No. 8) is acknowledged and has been entered. Previously pending claims 2, 3, 6 and 7 have been canceled and claim 1 has been amended. Claims 1, 4, 5, 11, 12 and 33 are currently being examined.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The following rejections are being maintained:

Claim Rejections - 35 USC § 112

4. Claims 1, 4, 5, 11, 12 and 33 remain rejected under 35 USC 112, first paragraph for the reasons previously set forth in Paper No. 8, Section 4, pages 2-5.

Applicant argues that the rejection should be withdrawn in view of the amendment in claim 1 that now covers only pentamers of units containing an oligomerization domain, a spacer and a binding domain. The argument has been considered but is not found persuasive because the rejection is drawn to the fact that there is no identification of any oligomerization domain that functions as contemplated, and now claimed, other than the COMP oligomerization domain. Although Applicant is not required to disclose every species encompassed by a genus, the description of a genus is achieved by the recitation of a representative number of molecules. The teaching of a single example is not sufficient description of a representative number of species that would serve as a written description for the genus claimed. For the reasons previously set forth, this is insufficient to support the generic claims. Further, Applicant does not address the other issues raised in the rejection drawn to spacers and the lack of structural information that

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could distinguish the compounds in the genus from others excluded. Applicant's arguments have not been found persuasive and the rejection is maintained.

5. Claims 1, 4, 5, 11, 12 and 33 remain rejected under 35 USC 112, first paragraph for the reasons previously set forth in Paper No. 8, Section 5, pages 5-10.

Applicant argues that, (a) in view of the amendment of claim 1, the rejection should be withdrawn, (b) claim 11 limits the pentamerization domain to the COMP domain. The arguments have been considered but have not been found persuasive (a') and (b) for the reasons set forth above and further because, as drawn to claim 11, Applicant has not addressed the issues raised drawn to a whole universe of acceptors and a whole universe of spacers or unpredictability of the spacer art and as drawn to all of the other claims, Applicant has not addressed the issues raised drawn to a whole universe of acceptors, a whole universe of pentamer oligomerization domains and a whole universe of spacers or unpredictability of the spacer art. Applicant's arguments have not been found persuasive and the rejection is maintained.

6. Claim 11 remains rejected under 35 USC 112, first paragraph for the reasons previously set forth in Paper No. 8, Section 6, page 10.

Applicant argues that Kajava describes the core COMP domain. The argument has been considered but has not been found persuasive because the use of laboratory designations only to identify a molecule renders the claims indefinite because different laboratories may use the same laboratory designations to define completely different molecules.

New Grounds of Rejection

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Claim Rejections - 35 USC § 112

7. Claims 1, 4, 5, 11, 12 and 33 are rejected under 35 USC 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4, 5, 11, 12 and 33 are indefinite because claim 1 recites the phrase "consists essentially of". The claims are indefinite because it is not clear what is encompassed by consisting essentially of and therefore the metes and bounds of patent protection claimed cannot be determined. The rejection can be obviated by amending the claim to delete the phrase "consists essentially of" and substituting the term "comprises".

8. All other rejections and objections recited in Paper No. 8 are withdrawn.

9.. No claims allowed.

10. Applicant's amendment necessitated the new grounds of rejection.

Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT

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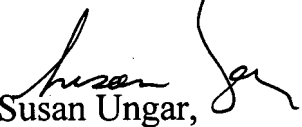
TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Ungar, PhD whose telephone number is (703) 305-2181. The examiner can normally be reached on Monday through Friday from 7:30am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached at (703) 308-3995. The fax phone number for this Art Unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Effective, February 7, 1998, the Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1640.


Susan Ungar,
Primary Patent Examiner
May 24, 2000